REMARKS

In the non-final Office Action mailed on July 31, 2003 (paper no. 5), the Examiner confirmed applicants' oral election of Group I, containing claims 1-17 and 27-29; objected to the specification; rejected claims 1-17 and 27-29 under 35 U.S.C. § 101; rejected claim 17 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-17 and 27-29 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,134,532 to Lazarus et al. ("Lazarus").

Applicants herein cancel claims 1-14, 16-17, and 27-29; amend claim 15; and present new claims 30-34 to more effectively capture the subject matter that applicants regard as their invention. As a result, claims 15, 18-26, and 30-34 are presently pending, of which claims 18-26 are withdrawn from examination. For the reasons discussed in detail below, applicants submit that each of these pending claims is now in condition for allowance.

Applicants would like to thank the Examiner for the courtesy extended to applicants' representative during the telephone interview conducted on October 6, 2003, during which the participants discussed the rejections under 35 U.S.C. §§ 101 and 103(a). In particular, the participants discussed three proposed new claims, which were indicated by the Examiner to overcome the rejection under 35 U.S.C. § 103(a). Versions of these three claims, modified in accordance with the discussion of them during the telephone interview, are presented herein as claims 30-32.

A.   Rejection Under 35 U.S.C. § 103(a)

Lazarus is directed to targeted advertising, in which advertisements are selected for presentation to specific users based upon profile information characterizing each user, such as the user's sex and age. As discussed during the telephone interview, all of the new claims presented herein recite testing advertising strategies by dividing the users into groups, and subjecting each group to a different advertising strategy. While each such advertising strategy may apply profile information of a particular user to select an advertising message for that user, advertising strategies are recited in all of the pending claims being selected for users without reference to information in their

profiles, such as by assigning users to strategies randomly, or in a way that conforms the relative size of the groups of users assigned to each strategy to predetermined relative sizes. Because Lazarus fails to assign users to advertising strategies being tested as recited, each of independent claims 15, 30, and 32 is patentable over Lazarus, as are their dependent claims 31, 33, and 34.

Support for the claim amendments may be found at 3:22-29 and 7:17-39.

During the telephone interview, the Examiner indicated that he did not believe that it would be possible to "without reference to any profile information for the user, assign [ ] the user to one advertising test group among a plurality of advertising test groups," as was recited in the version of claim 32 discussed during the telephone interview. The Examiner indicated that he regarded a user ID identifying the user as profile information for that user, which must be used to assign the user to an advertising test group or an advertising test subgroup. While applicants do not necessarily concur, they have accordingly revised claim 32 as presented herein to recite selecting an advertising test group and advertising test subgroup without reference to any profile information for the user, then assigning the user to the selected advertising test group and advertising test subgroup using the user's identifier.

B.   Restriction Requirement

Applicants herein affirm their earlier election of Group 1 containing claims 1-17 and 27-29.

C.   Objection To Specification

Applicants herein amend the specification to address the bases for this objection. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this objection.

D.   Rejection Under 35 U.S.C. § 101

Regarding the rejection under this Section of method claims, the Examiner indicated during the interview that these claims were rejected for "not being in the

technical arts." The Examiner further explained that this basis for rejection is predicated on a failure to explicitly recite in the body of a claim the performance of any action by a computing system, irrespective of whether a computing system is explicitly identified in the preamble as performing the entire method. While applicants in no way believe that adequate authority exists for such rejections, in order to advance examination of the application, they present only method claims that recite in their bodies the performance of one or more acts by a computing system. Accordingly, applicants submit that any similar rejection of the pending method claims would be unmerited.

With respect to rejected claim 15, this claim recites computer memories containing a data structure, and further recites the contents of the data structure. The Examiner indicated that the claim sets forth the data structure, which is not statutory subject matter, and does not provide a useful, concrete, and tangible result. While this may be true of a claim reciting a data structure per se, applicants submit that the following passage of the manual patent examining procedure clearly indicates that claims such as claim 15 reciting a computer-readable medium encoded with a data structure are statutory:

> Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. <u>In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.</u>

MPEP § 2106(IV)(B)(1)(a)

In view of the foregoing, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

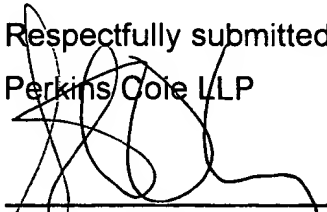E. Rejection Under 35 U.S.C. § 112, Second Paragraph

Applicants submit that the claim amendments herein overcome this rejection. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

F. Conclusion

In view of the foregoing, applicants submit that all of the elected claims are allowable. Accordingly, a prompt Notice of Allowance is respectfully requested. If the Examiner has any questions, or believes that a telephone conference would expedite examination of this application, he is encouraged to telephone the undersigned at (206) 359-6373.

Respectfully submitted,

Perkins Coie LLP

Date: 1/23/04

Steven D. Lawrenz
Registration No. 37,376

Correspondence Address:
Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 583-8888